

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on September 12, 2006. The application has been carefully reviewed in light of the Office action and interview, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

First, applicant notes that the Examiner has not indicated whether the drawings are accepted.

Claims 2-59 and 61-71 remain in this application. Claims 1 and 60 have been canceled. Claims 3-18, 32-39, 41-42, 44-46, and 49-68 have been withdrawn as the result of an earlier restriction requirement, and applicant retains the right to present those claims in a divisional application, although applicant notes that all of these claims depend on new claim 69, and thus should be re-introduced upon allowance of claim 69. New claims 72-73 are added without adding any new matter.

The examiner objected to claims various claims for lacking proper antecedent basis. The claims have been amended to correct this issue.

Claims 2, 20, 21, 26-29, 31, 32, 40, 47, and 69-71 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ritter (WO 99/35771) in view of Somoza *et al.* (U.S. 6,336,035). Claims 19 and 22-25 were rejected as above in further view of Baumann (U.S. 6,104,922). Claim 30 is rejected as for claim 69, in further view of Somaza *et al.* (U.S. 5,410,326), and claim 48 in further view of Yurino *et al.* (U.S. 6,810,386). For the following reasons, the rejections are respectfully traversed.

Claim 69, as amended, recites, *inter alia*, an order method for a user ordering at least one product or service of a provider, with the method comprising the steps of:

the user selecting the product or service using the
personal terminal;

the user terminal transmitting, to a remote server,
product data about the selected product or
service;

the remote server transmitting, to the user terminal,
an order parameter that is connected to the
selected offer based on the data about the
selected product or service;

and

executing, in said personal terminal, an order
program with which order data can be
entered, wherein at least certain order
parameters are used for adapting an entry
mask displayed by the order program
according to the selected offer;

As was discussed at the personal interview, neither Ritter nor Somoza teach such steps. In the Office action, the Examiner cites Somoza for teaching an adapted data entry mask. However, there is no teaching in Somoza of sending, to a remote server, product data about a product selected at a user terminal. Neither is there any teaching of the remote server sending an order parameter based on the selected product back to the user terminal. In fact, as discussed at the interview, there is no teaching in Somoza of the user terminal transmitting any data at all to an external server.

Instead, Somoza appears to disclose using a local database for generating a customized order form (see Fig. 1 and col. 4, lines 35-52 with col. 7,

lines 19-43). Although Somoza teaches that some information may be retrieved from a remote cite (see col. 5, lines 19-29), there is no teaching that this is done in response to a selected product, for example. Somoza is silent as to how this data retrieval accomplished. The Examiner basically agreed at the interview that such claim language would likely overcome his rejections if included in the claims.

The remaining references do not overcome the Somoza shortcomings. Accordingly, claim 69 is patentable over the reference. Claim 71, as amended, which recites a system for performing steps similar to the features discussed above, is thus patentable over the reference for similar reasons. New claim 72 has even more features not found in the references, and thus is also patentable over the references. The remaining claims, which depend, directly or indirectly, on one of the above discussed claims, are thus patentable over the references for at least the same reasons as the parent claim.

Furthermore, Somoza is not a relevant reference. The subject matter of Somoza relating to tools supporting the process of designing and outfitting a wireless network (see Title, Abstract and Background sections), and thus is not at all analogous to the subject matter of the invention, which pertains to online ordering systems. See MPEP §2141.01(a). The similarities and differences in structure and function of the inventions carry great weight in determining if art is analogous. See *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). The functions of the invention as compared to the Somoza system are quite different. Supporting the design of a wireless network is a specialized function, and is not related to a system for aiding online ordering of products and/or services. The function of the invention is a different field of endeavor entirely from the Somoza subject matter. Accordingly, the reference is not reasonably pertinent to the problem with which the inventor is concerned because a person having ordinary skill in the art of online product and/or services ordering would not reasonably have expected to solve that problem by

considering a reference dealing with tools for designing wireless networks. See *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the desirability of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner merely lists a generalized advantage of the combination based on a benefit of the secondary reference. This is not proper. Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references. Furthermore, merely listing a benefit of the secondary reference as "motivation" for modifying the primary reference is not enough, as any secondary reference

Appl. No. 10/082,831
Amdt. Dated September 20 2006
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has some "benefit". The Examiner must show why one of ordinary skill would provide that particular modification to the primary reference.

Accordingly, the rejections for obviousness is not supported by the Office action and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34359.

Respectfully submitted,
PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

1801 East Ninth Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

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